UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,659	12/21/2001	Leif O. Erickson	57347US002	2702

32692 7590 05/22/2003

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER
OSELE, MARK A

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/028,659	ERICKSON, LEIF O.	
	Examiner	Art Unit	
	Mark A Osele	1734	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-15 is/are rejected.

7)☒ Claim(s) 16 is/are objected to.

8)☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 21 December 2001 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3,5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-16, drawn to a splicing tape applicator, classified in class 156, subclass 159.

   II. Claims 17-18, drawn to an unrolling apparatus, classified in class 242, subclass 551.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the plurality of sensors and vacuum sources is not required to lift the outermost layer and apply a tape. The subcombination has separate utility such as unwinding a roll of material for a processing line.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Melissa Buss on April 3, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Dylla et al. (5,318,656). Dylla et al. '656 shows a method and apparatus for applying a splicing tape to a roll of sheet material comprising: lifting a portion of an outermost layer from a remainder of the roll (column 2, lines 21-24); cutting the leading edge (column 2, lines 24-28); applying splicing tape to a wound portion of the roll (column 2, lines 35-41, 43-48); and applying pressure with a roller to the lifted portion to progressively place the lifted portion of the outermost layer into contact with the splicing tape (column 7, lines 6-13).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2-3, and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dylla et al. '656 in view of McCormick et al. (5,524,844). As shown in paragraph 5 above, Dylla et al. '656 shows a method and apparatus for applying a splicing tape to a roll of sheet material. Dylla et al. '656 fails to show sheet engaging mechanism to lift the outermost layer of the roll. McCormick et al. teaches the use of a vacuum bar movable toward and away from a roll of material to lift the outermost layer so a splicing tape can be applied (column 3, lines 53-59; column 7, lines 22-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the vacuum sheet engaging mechanism of McCormick et al. into the apparatus and method of Dylla et al. '656 because McCormick et al. teaches that this system eliminates web material slack and wrinkles to permit a more accurate cut leading edge (column 7, lines 51-58).

Regarding claims 8 and 14, McCormick et al. shows that a hold down roller on the outermost layer is part of the system that reduces wrinkling (column 3, lines 36-48). Claims 2-3, 8-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dylla et al. '656 in view of McCormick et al. (5,524,844). As shown in paragraph 2 above, Dylla et al. '656 shows a method and apparatus for applying a splicing tape to a

roll of sheet material. Dylla et al. '656 fails to show sheet engaging mechanism to lift the outermost layer of the roll.

8. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dylla et al. '656 in view of McCormick et al. (5,524,844) as applied to claims 1 and 9 above and further in view of Wienberg et al. (5,916,651). As shown in paragraphs 5 and 7 above, Dylla et al. '656 shows a method and apparatus for applying a splicing tape to a roll of sheet material. Dylla et al. '656 fails to show sheet engaging mechanism to lift the outermost layer of the roll. Wienberg et al. shows the use of a splicing tape having a first section and a second section wherein the outermost layer covers the first section of the splicing tape and the second section remains exposed adjacent the outermost layer (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the dual section splicing tape of Wienberg et al. in the method of Dylla et al. '656 or the apparatus of Dylla et al '656 in view of McCormick et al. because Wienberg et al. shows that a single tape can be used to both hold down the leading edge of the outermost layer and bond the roll to a new roll in the splicing operation, thereby eliminating two tapes for those separate purposes.

Allowable Subject Matter

9. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: There is no suggestion or motivation in the prior art for using two pressing rollers on the outermost web to adhere it to the tape.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dylla et al. '230, Ganz, Krimsky et al., Nozaka, and Riegger each show web splicing methods and apparatuses using tapes on rolls.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Osele whose telephone number is 703-308-2063. The examiner can normally be reached on Mon-Fri 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

MARK A. OSELE
PRIMARY EXAMINER
May 19, 2003